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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,965	10/10/2000	Yuki Uchida	197849US-28	4230
22850	7590	09/02/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			DUONG, THOMAS	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 09/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/684,965	UCHIDA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Thomas Duong	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 May 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 52 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Amendment*

1. This office action is in response to the amendment filed on May 12, 2004. The amendment filed on May 12, 2004 has been entered and made of record. *Claims 1-51* are presented for further consideration and examination. *Claim 52* is restricted and will not be considered because it adds a new limitation that would necessitate a new search.

### *Response to Argument*

2. The Applicants' arguments and amendments filed on May 12, 2004 have been fully considered, but they are not persuasive.
3. With regard to claims 1, 13, 25, 37, 42 and 47, the Applicants point out that:
  - *Claims 1 and 37 of the present application recite, among other steps, a step of providing a user with consulting advice regarding a request. Claims 13 and 42 of the present application recite, among other features, means for providing a user with consulting advice regarding a request. Furthermore, Claims 25 and 47 recite, among other features, a computer code device configured to provide a user with consulting advice regarding a request. The specification of the present application discloses numerous non-limiting examples of such consulting advice. (See, e.g., page 2, lines 22-27, and page 6, lines 13-30.) The Applicants submit that the Becker et al. reference does not teach or suggest the above limitations.*
  - *The Becker et al. reference does not disclose or suggest any type of consulting advice being provided to the user regarding the user's request for an application.*

*The Becker et al. reference merely describes a method for selecting a file containing an application and passing that file to an application service provider for subsequent installation. No consultation is provided to the user regarding a selection.*

However, the Examiner finds that the Applicants' arguments are not persuasive and maintains that the Becker reference does disclose:

- *providing said user with consulting advice regarding said request; (Becker, col.5, lines 40-62; col.6, lines 32-58; fig.4; fig.7; Becker discloses a distributed data processing system that presents to the user a pop up window displaying available applications in response to a selection made by the user; Becker, also discloses an embodiment where the user can select a link and the system will display the applications available depending on the selected link)*

In summary, the Examiner maintains that Becker does disclose a distributed data processing system that presents to the user a pop up window displaying available applications in response to a selection made by the user (Becker, col.6, lines 32-58; fig.7). The presentation of available application choices to the user can be construed as recommending or advising the user of available applications to choose from.

Furthermore, the Becker reference also discloses an embodiment where the user can select a link and the system will display the applications available depending on the selected link. Again, this can be construed as recommending or advising the user of available applications to choose from. Therefore, the Applicants still failed to clearly disclose the novelty of the invention and identify specific limitation, which would define patentable distinction over prior art.

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4. With regard to claims 2-12, 14-24, 26-36, 38-41, 43-46 and 48-51, they are rejected at least by virtual of their dependency on the independent claims and by other reasons set forth in the previous office action. Accordingly, rejections for claims 2-12, 14-24, 26-36, 38-41, 43-46 and 48-51 are presented as below:

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 13, 25, 37, 42 and 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Becker et al. (US006658452B1).
7. With regard to claims 1, 13 and 25, Becker reference discloses,
- *receiving a request (application selection) from a remote user (clients 110-114 at the application provider server 104);* (Becker, abstract; col.2, lines 29-47; col.2, line 66 – col.3, line 12; col.4, lines 10-25; col.5, lines 17-26, lines 27-39; fig.1; fig.3-7)
  - *selecting an application service provider (server 104 to access suites of applications) based on said request;* (Becker, abstract; col.2, lines 29-47; col.2, line 66 – col.3, line 12; col.4, lines 10-25; col.5, lines 17-26, lines 27-39; fig.1; fig.3-7)

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- *forwarding said request to said application service provider; and (Becker, abstract; col.2, lines 29-47; col.2, line 66 – col.3, line 12; col.4, lines 10-25; col.5, lines 17-26, lines 27-39; fig.1; fig.3-7)*
- *receiving information from said application service provider indicating information of a document provided from said application service provider to said user.*  
*(Becker, col.5, lines 40-62; col.5, line 63 – col.6, line 5; col.6, lines 6-48; fig.4-7)*

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-8, 11-12, 14-20, 23-24, 26-32 and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Becker et al. (US006658452B1) and in view of Britton (US006591289B1).

10. With regard to claims 2, 5-7, 11-12, 14, 17-19, 23-24, 26, 29-31 and 35-36, Becker reference discloses the invention substantially as claimed,

See *claims 1, 13 and 25* rejection as detailed above.

However, Becker reference does not explicitly disclose,

- *further comprising the step of providing said user with said document from said application service provider.*
- *wherein the step of providing said document to said user comprises:*
  - *delivering a print out of said document to said user; and*
  - *providing said user with a URL of said document.*

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- *wherein the step of providing said document to said user comprises transmitting said document to a user storage device.*
- *wherein the step of providing said document to said user comprises transmitting said document to a user display device*

Britton teaches,

- *further comprising the step of providing said user with said document from said application service provider. (Britton, abstract; col.2, lines 13-32; col.3, line 56 - col.4, line 38; col.5, lines 53-65)*
- *wherein the step of providing said document to said user comprises:*
  - *delivering a print out of said document to said user; and (Britton, abstract; col.2, lines 13-32; col.3, lines 37-53; col.3, line 56 - col.4, line 38; col.5, lines 53-65)*
  - *providing said user with a URL of said document. (Britton, abstract; col.2, lines 13-32; col.3, line 56 - col.4, line 38; col.5, lines 53-65; col.6, line 45 – col.7, line 12)*
- *wherein the step of providing said document to said user comprises transmitting said document to a user storage device. (Britton, abstract; col.2, lines 13-32; col.3, line 56 - col.4, line 38; col.5, lines 53-65; col.6, line 45 – col.7, line 12; col.9, lines 28-45; col.10, lines 34-38)*
- *wherein the step of providing said document to said user comprises transmitting said document to a user display device (Britton, abstract; col.2, lines 13-32; col.3, line 56 - col.4, line 38; col.5, lines 53-65; col.6, line 45 – col.7, line 12; col.9, lines 28-45)*



Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Britton reference with Becker reference to further enhance the delivering of formatted document for viewing over a communications network, such as the internet, wherein information contained in the document is arranged into a pre-determined layout or file format upon request by the client.

11. With regard to claims 3-4, 8, 15-16, 20, 27-28 and 32, Becker and Britton references discloses the invention substantially as claimed,

See *claims 1, 13 and 25* rejection as detailed above.

However, Becker reference does not explicitly disclose,

- *further comprising the step of providing said application service provider with a user access level.*
- *further comprising the step of searching for said document in said application service provider.*
- *further comprising the steps of*
  - *retrieving said document;*
  - *formatting said document into a format requested by said user;*
  - *providing said user with said document formatted in said formatting step.*

Britton teaches,

- *further comprising the step of providing said application service provider with a user access level. (Britton, col.8, lines 33-54; col.10, lines 12-14)*
- *further comprising the step of searching for said document in said application service provider. (Britton, abstract; col.2, lines 13-32; col.3, line 56 - col.4, line 38; col.5, lines 53-65; col.6, line 45 – col.7, line 12; col.9, lines 28-45; col.10, lines 34-38)*

- *further comprising the steps of*
  - *retrieving said document; formatting said document into a format requested by said user; providing said user with said document formatted in said formatting step. (Britton, col.3, lines 10-36; col.10, lines 10-19; col.17, lines 56-57)*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Britton reference with Becker reference to further enhance the delivering of formatted document for viewing over a communications network, such as the internet, wherein information contained in the document is arranged into a pre-determined layout or file format upon request by the client.

12. Claims 9-10, 21-22 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Becker et al. (US006658452B1), in view of Britton (US006591289B1) and further in view of Smith (US006385655B1).
13. With regard to claims 9-10, 21-22 and 33-34, Becker and Britton references disclose the invention substantially as claimed,

See *claims 1-2, 13-14 and 25-26* rejection as detailed above.

However, Becker and Britton references do not explicitly disclose,

- *further comprising the steps of*
  - *generating a unified bill from bills received from application service providers;*
  - and*
  - *transmitting said unified bill to said user.*
- *wherein the receiving information step comprises receiving the information which is a billing information.*

Smith teaches,

- *further comprising the steps of*
  - *generating a unified bill from bills received from application service providers; and transmitting said unified bill to said user. (Smith, abstract; col.3, lines 37-44; col.7, lines 60-67)*
- *wherein the receiving information step comprises receiving the information which is a billing information. (Smith, abstract; col.3, lines 37-44; col.7, lines 60-67)*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Smith reference with Becker and Britton references to further enhance the delivering controlled of formatted document for accounting purposes over a communications network, such as the internet, wherein information contained in the document is arranged into a pre-determined layout or file format upon request by the client.

14. With regard to claims 38-41, 43-46 and 48-51, they include features or limitations as in *claim 9*. Thus, *claims 38-41, 43-46 and 48-51* are also rejected under the same rational as cited in the rejection of the *claim 9*.

### **Conclusion**

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE

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MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Duong whose telephone number is 703/305-1886 or 571/272-3911 (after 11/01/2004). The examiner can normally be reached on M-F 7:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on 703/308-5221 or 571/272-3923 (after 11/01/2004). The fax phone numbers for the organization where this application or proceeding is assigned are 703/872-9306 for regular communications and 703/872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/305-3900 or 571/272-2100 (after 11/01/2004).

*Thomas Duong (AU2143)*

*August 25, 2004*

  
DAVID WILEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100